

REMARKS

Favorable reconsideration and allowance of the present application in view of the foregoing amendment and following remarks are respectfully requested.

Currently, claims 1 through 33 are pending in the application. Claim 1 is an independent claim, with claims 2 through 9 depending therefrom. Claim 10 is an independent claim, with claims 11 through 20 depending therefrom. Claim 21 is an independent claim, with claim 22 depending therefrom. Claim 23 is an independent claim, with claims 24 through 33 depending therefrom.

The following is a brief summary of the Examiner's Action of November 16, 2003 and the references cited therein. Claims 1, 2, 3, and 10 have been rejected under 35 U.S.C. § 102(b) for alleged anticipation by Schwartz et al. (U. S. Patent No. 5, 894,597). Claims 1, 2, 3, 4, 5, 9, 10, and 12 stand rejected under 35 U.S.C. § 102(b) for alleged anticipation by Taylor (U. S. Patent No. 5, 987,325). Claims 1, 2 through 10, 12 through 16, and 21 through 29 stand rejected under 35 U.S.C. § 102(b) for alleged anticipation by Bricaud (WO 00/17806). Claims 6 through 9 and 13 through 16 stand rejected under 35 U.S.C. § 103(a) for alleged obviousness over Taylor in view of Bricaud. Claims 11, 17 through 20, 24, and 30 through 33 are objected to as being dependent upon a rejected based claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There are no objections either to the drawings or to the specification.

Applicants have amended claims 11, 17, 24, and 30 to rewrite them in independent form, including all of the limitations of the base claim and any intervening claims. In

consideration of these amendments, Applicants urge that claims 11, 17, 24, and 30 are now in condition for allowance.

Applicants have amended claim 1 to include the limitations of the second card holder slide assembly being separate from the first card holder slide assembly, and the housing being in simultaneous electrical contact with both the first and second card holder slide assemblies. It is urged that claim 1 patentably distinguishes over the references cited in the November 16, 2003 Office Action and should be allowed. Claims 2-9 depend from claim 1, patentably distinguish over the references cited in the November 16, 2003 Office Action for at least the same reasons, and likewise should be allowed.

Applicants reply herein to every ground of objection and rejection in the November 16, 2003 Office Action. For ease of reference, the remarks herein are divided and outlined according to each such ground.

1. Schwartz

Applicants respectfully submit that claim 1 and original claims 2, 3, and 10 are patentably distinct and allowable over Schwartz. Schwartz is cited as grounds for rejection pursuant to 35 U.S.C. § 102(b), for anticipation.

In the November 16, 2003 Office Action, beginning on page 2 and continuing to page 3, Schwartz is described as teaching "said housing 102 in communication with both said first card holder slide assembly and said second card holder slide assembly (the card reader 102 is used to read both SIM 101 and SIM 108) (col. 2, lines 15- 30))." Applicants respectfully traverse. Schwartz does not disclose communication with both the first card holder slide assembly and the second card holder slide assembly. To the contrary, Schwartz discloses the opposite: communication with one or the other, but not both. As

revealed, for example, within the portion of Schwartz cited by the Examiner, column 2, lines 15-30, what is disclosed is:

The card reader accommodates a chip card 101 in a chip card support 104. The chip card support 104 is mounted on a door 105 that is opened to receive the chip card and closed to position the chip card on card reader contacts (416 on Fig. 4) of a contact assembly 106. A large card 108 is inserted into a slot 110 and slides between circuit board 112 and the chip card support 104. The large card 108 pushes the chip card support 104 away from contacts of the contact assembly 106 while the SIM moves through communication device 100. This allows the card reader 102 to accommodate either a large card 108 or a chip card."

Thus, Schwartz discloses only a device that may carry two cards at one time, but may only read one card at a time. Specifically, the apparatus of Schwartz may read chip card 101 unless a large card 108 is inserted, wherein such a large card 108 would push the chip card support 104 away from the contacts and thus out of electrical communication with the contacts. Further such disclosure is reiterated elsewhere in Schwartz:

In this alternate embodiment, the chip card support 104 will move out of the path of the large card 108 when the chip card 101 is in the chip card support 104 and when the chip card is not in the chip card support 104, allowing both cards to be mounted. However, when a large card 108 is loaded in the communication device, and a chip card is loaded in the chip card holder, the large card 108 will be positioned between the chip card and the contact assembly. (Col. 3, lines 62 through col. 4, line 3).

The disclosure of Schwartz, therefore, is inconsistent with and contrary to electrical communication or contact with both the first card holder slide assembly and the second card holder slide assembly.

At page 12, the November 16, 2003 Office Action asserts that "neither independent claims 1 nor 10 recite the limitation 'at once' as argued. Therefore, Schwartz still

anticipates the claimed limitation.” As currently amended, claim 1 provides, “said housing in simultaneous electrical contact with both said first card holder slide assembly and said second card holder slide assembly.” The limitation does not provide that the housing is in electrical communication with either the first or second card holder slide assembly, or one at a time, or alternatively, as disclosed by Schwartz. Instead, electrical contact between the housing and both the first card holder slide assembly and the second card holder slide assembly is provided. Such a limitation is not found expressly within Schwartz, and cannot be found inherently in Schwartz because Schwartz teaches exactly the opposite – Schwartz teaches contact either with the first or with the second, but not with both.

Because the limitation of the housing being in simultaneous electrical contact with both the first card holder slide assembly and the second card holder slide assembly is not disclosed by Schwartz, Schwartz cannot anticipate claim 1 pursuant to 35 U.S.C. § 102(b). Because claims 2 and 3 depend from claim 1, neither can Schwartz anticipate them. For these reasons, claims 1, 2, and 3 should be allowed over Schwartz.

Additionally, as to the asserted rejection of the claim 10 based on Schwartz, Applicants respectfully traverse. Claim 10 includes as its last limitation, “wherein the first set of electrical contacts engage the first SIM card and the second set of electrical contacts engage the second SIM card.” As described and articulated above, Schwartz’s disclosure does not contain such a configuration. Instead, the disclosure of Schwartz is exactly the opposite to such limitation, and is inconsistent with electrical engagement with the first card and the second card. Instead, Schwartz’s disclosure is for electrical contact with the first card or the second card. As quoted above, with the apparatus of Schwartz, insertion of the

second card removes the first card from electrical engagement. Therefore, Schwartz cannot anticipate claim 10.

2. TAYLOE

Tayloe is also asserted to anticipate the invention claimed in claims 1, 2, 3, 4, 5, 9, 10, and 12. Specifically, page 4 of the November 16, 2003 Office Action asserts that,

Tayloe teaches ... a first set of electrical contacts in SIM card reader 107 (Fig. 2) carried upon the housing; inherently a second set of electrical contacts 107 in SIM card reader 107 (Fig. 2) carried upon the housing; a first card holder slide assembly 107 (Figs. 1-2) adapted to receive a first electronic card 105; and a second card holder slide assembly 107 (Figs. 1-2) adapted to receive a second electronic card 105....

That is to say, SIM card reader 107 is also asserted in the Office Action to be the first card holder slide assembly 107.

Tayloe does not contain such disclosure. Claims 1 and 10 recite first and second card holder slide assemblies. Tayloe discloses no such card holder slide assemblies. Instead, Tayloe discloses insertion of the cards directly into a telephone. For example, Fig. 1 of Tayloe explicitly depicts cards 105 to be inserted directly into holes 107 which include card readers therein. Component 107 of Tayloe is defined and disclosed to be a card reader, not a card holder slide assembly – see, for example, Fig. 2; see also, for example, Col. 3, line 3. Tayloe is also inherently limited, in that it discloses in Fig. 2 the radio telephone system 100 (col. 3, line 14), depicted in Fig. 2 by dash lines, in which card readers 107 are already located. As disclosed by Tayloe, cards 105 are “inserted into the phone.” (Col. 5, lines 32-33). No disclosure is provided in Tayloe for first and second card holder slide assemblies adapted to receive, respectively, first and second electronic cards. Accordingly, Tayloe discloses a telephone configured for receipt of SIM cards only, and

does not contemplate nor disclose receipt of first and second card holder slide assemblies with electronic cards. Accordingly, the limitations of independent claims 1 and 10 are not disclosed by Tayloe. Moreover, because claims 2, 3, 4, 5, and 9 depend from claim 1, and because claim 12 depends from claim 10, neither does Tayloe anticipate them. For these reasons, claims 1, 2, 3, 4, 5, 9, 10, and 12 are patentably distinct over Tayloe.

3. BRICAUD

Bricaud is cited in the Office Action as anticipating numerous of Applicants pending claims under 35 U.S.C. § 102(b).

Bricaud cannot anticipate Applicants' claims under § 102(b). The International Publication Date of Bricaud is revealed on the face page thereof to be March 30, 2000. Applicants' application was filed November 30, 2000. Accordingly, by the terms of 35 U.S.C. § 102(b), Bricaud cannot anticipate Applicants' claims.

Responding to the merits of the Office Action relative to Bricaud, Bricaud is asserted against independent claims 1, 10, 21, and 23, as well as multiple dependent claims depending from these independent claims. Because Bricaud does not disclose each and every limitation of the independent claims (and therefore neither the dependent claims depending therefrom), Bricaud cannot anticipate the pending claims of Applicants' application.

Specifically, claim 1 provides for a first card holder slide assembly and a second card holder slide assembly. Bricaud does not have a first and a second card holder slide assembly. Bricaud has only one card holder slide assembly. Such a single card holder slide assembly is revealed, for example, in Bricaud in Figs. 2, 3, 9, 10, and elsewhere. The November 16, 2003 Office Action asserts that Bricaud discloses a first card holder slide

assembly 152 and a second card holder slide assembly 154 (see November 16, 2003 Office Action, at page 5). However, components 152 and 154 of Bricaud are not card holder slide assemblies. Instead, as is explicitly articulated in Bricaud, components 152 and 154 are compartments. Particularly, Bricaud provides:

The card-holder slide-in unit 54 is a moulded [*sic*] plastic component which essentially consists of a horizontal plate 150 forming a horizontal partition that separates an upper compartment 152 intending to house the MMC upper card 56 from a lower compartment 154 intended to house the MICSIM lower card 58. (Page 18, lines 13-18).

Further details regarding the slide in unit 54, as well as compartments 152 and 154, are provided from page 18, line 11 through page 19, line 21, and other locations, within Bricaud. At no point in Bricaud are a first and a second card holder slide assemblies disclosed. Only a single card holder slide-in unit 54 is disclosed.

Bricaud reveals a single card-holder slide-in unit 54 such as depicted in Figs. 9 and 10 is adapted for receipt of two cards, such as depicted in Figs. 11, 12, 13, 14, 25c, 33, 34, 35, 36, 56, 69, 72, and 74. This single card-holder slide-in assembly is thereupon fitted within a connector, as depicted, for example, in Figs. 2, 3, and 18. It will be appreciated, then, that removal of a single card from such an assembly would require removal of the card-holder slide-in assembly from the connector, which necessarily would remove both of the cards in the single-holder slide-in assembly. Removal of one card from the Bricaud apparatus requires removal of both cards, since both cards are connected to the assembly by the single-card slide-in component.

Bricaud does not disclose the limitations of previously-amended independent claim 1: a first card holder slide assembly and a second card holder assembly. Bricaud only discloses a single card holder slide assembly.

Bricaud likewise does not disclose the limitations of claim 10: a first card holder slide assembly and a second card holder slide assembly.

Bricaud also does not disclose, and is not enabling of, the limitations of original claim 21, a method claim: providing a first card holder slide assembly adapted to receive a first SIM card, inserting the first SIM card into the first card holder slide assembly to form a first loaded slide assembly, placing the first loaded slide assembly into operative position within the housing, engaging the first set of electrical contacts with the first SIM card, and providing a second card holder slide assembly adapted to receive a second SIM card.

Bricaud also does not disclose the limitations of original, independent claim 23: a first card holder slide assembly and a second card holder slide assembly.

Because claims 1, 10, 21, and 23 are not anticipated by Bricaud, neither can the independent claims depending from them be anticipated. For these reasons, claims 2 through 9, 13 through 16, and 23 through 29 should be allowed over Bricaud.

4. OBVIOUSNESS REJECTIONS

Claims 6 through 9 and 13 through 16 stand rejected under 35 U.S.C. § 103(a) as obvious over Tayloe in view of Bricaud.

The question of obviousness is not simply a question of finding references that, if combined, would include the necessary limitations. Instead, the Federal Circuit has consistently held that the question of obviousness requires a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley vs. Franklin Sports, Inc., 262 F3d. 1339, 60 U.S.P.Q. 2d 1001 (Fed. Cir. 2001) ("the central question is whether there is reason to combine references").

Regarding claims 6 and 7, Tayloe contains no teaching, motivation, or suggestion of any desire to use elongated contact elements, or curved, resilient contact tips. Indeed, Tayloe contains no teaching regarding the configuration of contact elements, much less any teaching, motivation, or suggestion for elongated contact elements or curved, resilient contact tips.

Dependent claim 8 calls for elongated contact elements electrically engaged with electronic cards at multiple contact points. Claim 8 depends from 6, which in turn depends from claim 1, which requires first and second card holder slide assemblies. The Office Action points to Fig. 25, components 100 and 146 of Bricaud as support for the proposition of obviousness, yet Bricaud discloses contact with a card mounted in a compartment of a single card-holder slide-in unit and Tayloe has no contemplation of such a card holder and instead relies upon direct insertion of cards into a telephone. There is no teaching in either Tayloe or Bricaud suggestive of the invention of claim 8 using two card holder slide assemblies and elongated contact elements electrically engaged with first and second electronic cards at multiple contact points. No disclosure in either Tayloe or Bricaud suggests such a combination.

The Office Action asserts that Tayloe in view of Bricaud teaches operation of the card reader in a cellular telephone and that claim 9 is therefore obvious. However, claim 9 depends from claim 1, in which it is provided that a first card holder slide assembly and a second card holder slide assembly are provided and that a housing is in simultaneous electrical contact with both. Neither Tayloe nor Bricaud, alone or in combination, provide any teaching, motivation, or suggestion for such an apparatus.

As to claim 13, the Office Action asserts that "Tayloe as modified also teaches that said first and second card holder slide assemblies each comprise a flat base with a plurality of walls...." However, the apparatus in Tayloe not only does not have a first and second card holder slide assembly, Tayloe does not have any card holder slide assembly at all. Instead, as revealed at column 3, lines 2-4, the apparatus in Tayloe contemplates one or two cards being inserted by the user into the card readers contained within the telephone. Tayloe contains no suggestion for a first and second card holder slide assembly. Moreover, neither does Bricaud suggest the use of a first and second card holder slide assembly. Instead, as disclosed at page 18, line 13, through page 19, line 21, Bricaud only teaches the use of a single-cardholder slide-in unit that contains an upper compartment 152 and a lower compartment 154.

Regarding claim 14, Bricaud is asserted in the Office Action as teaching at least one card holder slide assembly comprising an aperture window, and in support of such proposition Fig. 36, Numeral 58 is referenced. To the contrary, though, Bricaud component 58 in Fig. 36 is not an aperture window at all; component 58 is a card. Specifically, Bricaud discloses on page 24, line 15, that component 58 is a card, not an aperture.

As to claims 15 and 16, the remarks hereinabove concerning claims 6, 7, and 8 apply equally, to refute the contention of obviousness and are incorporated herein by reference as to claims 15 and 16.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and allowance of the pending claims. It is believed that the present application is in

complete condition for allowance and favorable action, therefore, is respectfully requested.


If, after consideration of the foregoing, however, any issues remain after consideration of this response the Examiner is invited to telephone the undersigned at convenience.

If any fee beyond that submitted herewith, or extension of time is required, the undersigned hereby petitions the Commissioner to grant any necessary time extension and authorizes charging Deposit Account 04-1403 for any such fee not submitted herewith.

Respectfully submitted,

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